

REMARKS

Claims 1, 3-6, 8, and 16-33 are all the claims pending in the application, claims 2, 7, and 9-15 having previously been canceled, and claims 16-33 having been previously added. Claims 1, 5, 8, 24, and 30 are the only independent claims.

As a preliminary matter, Applicant notes that the previous Office Action in this application included objections to claims 1 and 3. It is believed that the previously submitted claim amendments resolved the matter since the present Action did not contain such claim objections. Applicant respectfully requests confirmation that the previously identified claim objections have been withdrawn.

Claims 1, 5, 6, 8, 16, 17, and 20-33 stand rejected under 35 U.S.C. §102(e) as being anticipated by Shimamura et al. (U.S. patent 6,808,773). Claims 25 and 26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shimamura. Claims 3, 4, 18, and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shimamura in view of Saito et al. (U.S. patent 6,469,440). Applicant respectfully traverses these rejections, and requests reconsideration and allowance of the pending claims in view of the following arguments.

Substance of Interview

As a preliminary matter, Applicant gratefully acknowledges the courtesies extended by the Examiner in the April 17, 2006, telephone interview with Applicant's representative, Jeffrey Lotspeich. Prior to the interview, the Examiner was provided with a proposed Response, which was the same as the present Response in all relevant parts. Pursuant to M.P.E.P. § 713.04, Applicant provides the following remarks.

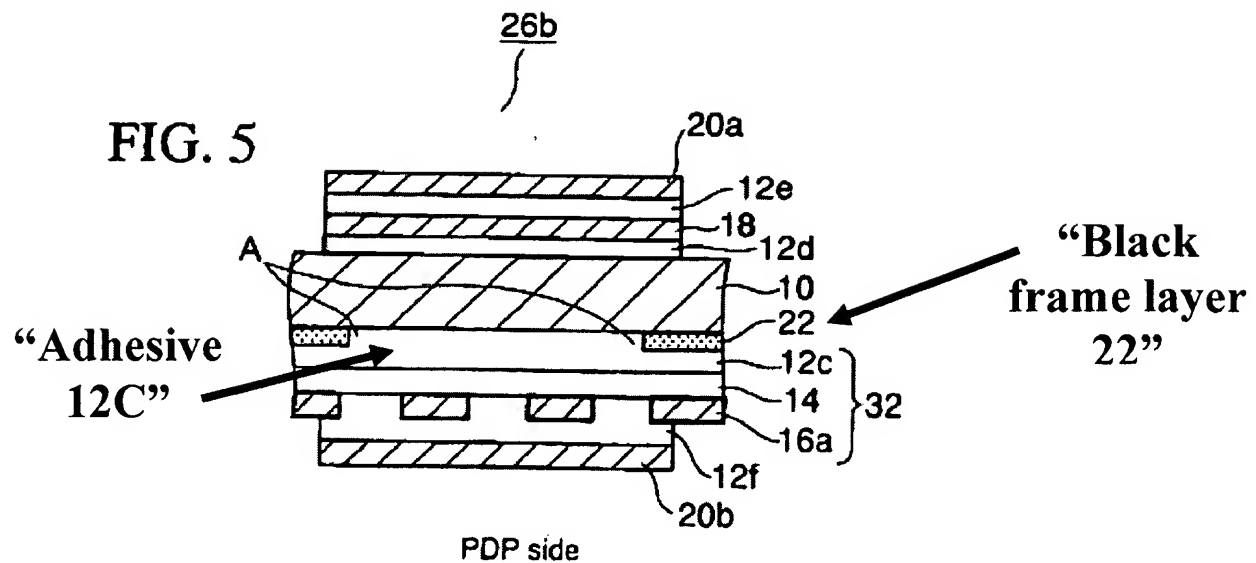
The Examiner acknowledged Applicant's position set forth in the proposed Response, and agreed that the claims of the present application appeared to define over the currently cited art. The Examiner indicated the present rejection will likely be withdrawn, but a more-detailed review of the claims and other references of record are necessary before a final determination of the patentability of the claims could be determined.

Rejection under 35 U.S.C. §102(e)
as being anticipated by Shimamura

The Examiner rejects Claims 1, 5, 6, 8, 16, 17, and 20-33 under 35 U.S.C. §102(e) as being anticipated by Shimamura.

Claim 1 recites "a frame adhesive having a transparent adhesive formed at an active display area of the plasma display panel and a black adhesive formed at a nonactive display area surrounding the active display area." Although Shimamura purportedly provides transparent adhesive arranged over various portions of the components shown in Fig. 5 of that patent, Shimamura provides absolutely no disclosure relating to the use of a "black adhesive" in accordance with claim 1.

Applicant provides below an annotated Fig. 5 of Shimamura, which is asserted in the Action as teaching the various elements of claim 1.



Applicant: “Black frame layer 22” is not an adhesive

The Action alleges that black frame layer 22 of Shimamura teaches the claimed “black adhesive.” The Action reasoned that black frame layer 22 “must necessarily adhere to the substrate for the layers to bond together.” Action, pg. 3. Applicant respectfully disagrees with this position for the following reasons.

First, a “frame layer” is not the same thing as the claimed “black adhesive.” Frame layers and adhesives are completely different objects serving entirely different purposes.

Second, black frame layer 22 of Shimamura does not teach or suggest any adhesive, much less the claimed “black adhesive.” Annotated Fig. 5, as set out above, clearly supports this position. Shimamura most certainly envisioned the use of adhesive layers in conjunction with the embodiment of Fig. 5. Indeed Fig. 5 depicts a variety of different layers, some of which are adhesive layers (i.e., layers 12e, 12d, 12c, and 12f). Applicant submits that if Shimamura intended to teach the use of an adhesive between layer 22 and substrate 10, as suggested in the Office Action, then Fig. 5 would surely have provided such a teaching. Applicant emphasizes

that Shimamura explicitly discloses the use of adhesive layers at certain locations. However, none of these locations include the use of adhesive between frame layer 22 and substrate 10. To find otherwise directly contradicts the teachings of this reference.

Third, as noted above, the Action reasoned that black frame layer 22 teaches the claimed “black adhesive” since black frame layer 22 “must necessarily adhere to the substrate for the layers to bond together.” Office Action, pg. 3. Applicant respectfully disagrees. In all likelihood, what is required by the Fig. 5 invention is that black frame layer 22 remains in a fixed spatial relationship to substrate 10. The Action indicated that this must occur by adhering layer 22 to substrate 10. However, Shimamura seems to suggest otherwise. For example, Applicant invites the Examiner’s attention to col. 12, lines 53-59. This passage implies that adhesive layer 12c buries the stepped portions of black frame layer 22. This means that adhesive layer 12c (not some other “black adhesive” as referred to in the Action) adheres or otherwise maintains layer 22 in position.

As a fourth point, Applicant assumes *arguendo* that Shimamura suggests the use of an adhesive to adhere black frame layer 22 to substrate 10. Even if this were true, Shimamura provides absolutely no suggestion as to the color of such an adhesive. Put another way, even if Shimamura suggests an adhesive, there is no disclosure that implies that this adhesive is black.

As a fifth point, the Action appears to assert that the black frame layer 22 of Shimamura inherently teaches the claimed “black adhesive.” Applicant respectfully points out that according to MPEP § 2112, “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (emphasis in original)). “To establish inherency, the extrinsic evidence must make clear that the missing

descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' “ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Applicant submits that the Action has not met the necessary burden for establishing inherency with regard to the claimed “black adhesive.” For instance, even if it were possible that black adhesive could be used to secure black frame layer 22 to substrate 10, the Action has not established the facts necessary which demonstrate that the black adhesive would necessarily be used in such a manner. Upon reviewing Shimamura, one would not necessarily realize that black adhesive could be used in the manner recited in the claims. Indeed, one is led in an entirely different direction. Recall that Shimamura implies the use of adhesive layer 12c (which by the way is not a “black adhesive”) for securing black frame layer 22 to substrate 10. For these reasons, the claimed “black adhesive” is clearly not inherent in view of the teachings of Shimamura.

Applicant submits that none of the other references of record supply the stated deficiencies of Shimamura. In view of the foregoing, Shimamura fails to teach or suggest a number of features recited by claim 1, and therefore this claim is believed to be patentable.

Independent claims 5, 8, 24, and 30 are patentably distinct for similar reasons. For example, Shimamura does not teach or suggest “one of the plurality of adhesives is a frame

adhesive having a black adhesive for defining an active display area of the plasma display panel,” as recited by claim 5. Moreover, Shimamura does not teach or suggest “forming a black adhesive at a nonactive display area of the plasma display panel” as recited in each of claims 8, 24, and 30. For these reasons, independent claims 5, 8, 24, and 30 are also believed to be patentable, and dependent claims 6, 16, 17, 20-23, 25-29, and 31-33 are patentable at least by virtue of their dependence on the patentable independent claims.

Rejection Under 35 U.S.C. §103(a)
as being unpatentable over Shimamura and Saito

The Examiner rejects claims 25 and 26 under 35 U.S.C. §103(a) as being unpatentable over Shimamura, and claims 3, 4, 18, and 19 under 35 U.S.C. §103(a) as being unpatentable over Shimamura in view of Saito.

Applicant has demonstrated above that Shimamura does not teach or suggest the “black adhesive” feature recited by claims 1, 5, and 24. Applicant further notes that none of the cited references supply any of the stated deficiencies of Shimamura. Therefore, dependent claims 3, 4, 18, 19, 25, and 26 are believed to be patentable at least by virtue of their dependence on their respective independent claims.

CONCLUSION

In light of the above remarks, Applicant submits that the present Response places all claims of the present application in condition for allowance. Reconsideration of the application is requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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By: _____



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